

THEOR 205.1 US (10107436)REMARKSRECEIVED
CENTRAL FAX CENTER

JAN 15 2008

Status of the Claims

Claims 1-18 are currently pending

Claims 1 – 18 stand rejected.

Claim Rejections

Claims 1-16 are rejected under 35 U.S.C § 102(e) as allegedly being anticipated by U.S. Patent No. 6,199,195 ("Goodwin"). Claims 17-18 are rejected under 35 U.S.C § 103(a) as allegedly being unpatentable over the combination of Goodwin in view of U.S. Patent No. 6,944,680 ("Lee"). Applicant respectfully traverses this rejection.

Anticipation Rejections

A rejection based on 35 U.S.C. § 102 as in the present case, requires that the cited reference *disclose each and every element* covered by the claim. *Electro Medical Systems S.A. v. Cooper Life Sciences Inc.*, 32 U.S.P.Q.2d 1017, 1019 (Fed. Cir. 1994); *Lewmar Marine Inc. v. Bariant Inc.*, 3 U.S.P.Q.2d 1766, 1767-68 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2D 1051, 1053 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987). The United States Court of Appeals for the Federal Circuit has mandated that 35 U.S.C. § 102 requires no less than "complete anticipation." *Connell v. Sears, Roebuck & Co.*, 772 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983). "Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Id.*; *see also Connell v. Sears, Roebuck & Co.*, 772 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); *see also, Electro Medical Systems*, 32 U.S.P.Q. 2d at 1019; *Verdegaal Bros.*, 814 F.2d at 631. Here, the Examiner has failed to establish a case that Goodwin is an anticipatory reference under 35 U.S.C. §102(b) because it fails to teach none of the limitations of independent claim 1. Accordingly, it is unclear to applicant why Goodwin is relevant as a prior art reference when it fails to teach or suggest any of the claimed steps of claim 1.

THEOR 205.1 US (10107436)

Contrary to the Examiner's assertion, Goodwin does not teach or suggest the step of "analyzing a business domain to determine functional requirements of said business domain," as required in claim 1. In fact, the passage cited by the Examiner (Goodwin, col. 11, lines 36-55), teaches that a meta object facility defines and manipulates a set "of meta models." Goodwin explains that a "model is a set of business objects that makes up a running software application." (Goodwin, col. 11, lns. 38-40). Thus, Goodwin merely teaches identifying and manipulating pre-existing software objects that make up a running software application. The present invention, however, *analyzes business domains* to determine *functional requirements* of the *business domain*. A business domain includes business problems or projects (*see*, specification, page 3, lines 14-15; Abstract). It is appreciated that one of ordinary skill in the art would not equate "meta models" with "business projects." Moreover, the present invention necessarily analyzes the business domains to determine functional requirements prior to even generating any "models." (specification, pg. 7, ln. 19 – 22; *see also*, pg. 7, ln. 19 – pg. 12, ln. 17). The very purpose of analyzing the business domain is to first determine the functional requirements to eventually generate a model. Goodwin, however, does not teach the analysis of any business domain to determine functional requirements. "To imbue one of ordinary skill in the art with knowledge of the present invention, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim of the insidious effect of hindsight syndrome, wherein that which only the inventor taught is used against the teacher." *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983). Applicant respectfully submits that the Examiner cannot use hindsight gleaned from the present invention to contradict the clear teaching of the prior art reference to render claims unpatentable. The prior must to be judged based on a full and fair consideration of what that art teaches, not by using Applicant's invention as a blueprint for gathering various bits and modifying the pieces in an attempt to reconstruct Applicant's invention. Therefore, because Goodwin fails to teach or suggest the step of analyzing as required in claim 1 (and included in dependent claims 2-18), it follows that,

THEOR 205.1 US (10107436)

contrary to the Examiner's assertion, Goodwin does not anticipate claim 1, or any of dependent claims 2-18.

Contrary to the Examiner's assertion, Goodwin does not teach or suggest the step of "transforming said functional requirements into an EJB component model," as required by independent claim 1. In fact the passage cited by the Examiner (Goodwin, col. 7-8, lines 53-67 and 1-5), is directed to transforming data models into code: "[t]he system . . . provides application developers with a . . . approach . . . for generating code from a data model." (Goodwin, col. 7, lns. 66-67). On the other hand, the transforming step of the present invention requires that the *functional requirements* determined from analyzing the business domain be transformed into an EJB component *model* NOT into the code resulting from the data model. The Goodwin passage is directed to the transformation of a data model to code, which requires that the model already have been generated. The transforming step of the present invention, however, is directed to transforming the functional requirements determined from analyzing the business domain into an EJB component model. The prior must be judged based on a full and fair consideration of what that art teaches, not by using Applicant's invention as a blueprint for gathering various bits and modifying the pieces in an attempt to reconstruct Applicant's invention. Therefore, because Goodwin fails to teach or suggest the step of transforming as required in claim 1 (and included in dependent claims 2-18), it follows that, contrary to the Examiner's assertion, Goodwin does not anticipate or render obvious claim 1, or any of dependent claims 2-18.

Contrary to the Examiner's assertion, Goodwin does not teach or suggest the step of "building an EJB component in accordance with said EJB component model that encompass the business functionality of said business domain," as required in claim 1. In fact, the passage cited by the Examiner (Goodwin, col. 12, lines, 25-25), generally explains that the repository adapter tool 312 uses "logical models from various modeling tools to generate the unified models" and that "each object within a unified model represents a unique structural feature of a software system." (Goodwin, col. 12, lns. 26).

THEOR 205.1 US (10107436)

This passage does not teach building an EJB component in accordance with EJB component models that encompass the *business functionality* of a *business domain*. It is respectfully submitted that Goodwin is merely teaching a system for generating source code by translating logical models into unified models and then generating a plurality of templates related thereto and generating the source code therefrom. (See, e.g., col. 3, lns. 3 – 26). Goodwin does not teach or suggest the claimed step of “building an EJB component in accordance with said EJB component model that encompass the business functionality of said business domain,” as called for in claim 1. It is well established that the Examiner cannot use hindsight gleaned from the present invention to modify or reconstruct the prior art reference to render claims unpatentable. As such, because Goodwin fails to teach or suggest the step of building as required in claim 1 (and included in dependent claims 2-18), it follows that, contrary to the Examiner’s assertion, Goodwin does not anticipate claim 1, or any of dependent claims 2-18.

Goodwin also does not teach or suggest at least the following additional elements taught by dependent claims 2, 4-7, and 10-16:

Claim 2: Goodwin nowhere discloses providing a parallel development process.

Claim 4: Goodwin does not teach or suggest functional requirements let alone functional requirements the include data and process model of the business domain.

Claim 5: Goodwin does not teach or suggest EJB component model which encapsulates the data and process model of the said business domain.

Claim 6: Goodwin does not teach or suggest generating a list of inputs wherein each input identifies a resource relating to the business domain.

Claim 7: Goodwin does not teach or suggest generating eFunction matrix from a list of inputs.

Claim 10: Goodwin does not teach or suggest building the EJB component from at least one of the following class stereotypes: Belonging, Session, Entity, Configurable Entity, Business Policy and Workflow.

THEOR 205.1 US (10107436)

Claim 11: Goodwin does not teach or suggest mapping eXtensible Markup Language (XML) to the EJB component model.

Claim 12: Goodwin does not teach or suggest dividing the business domain into one or more sub-domains, determining functional requirements for each of the sub-domains; and transforming each of the functional requirements for the sub-domains into the EJB component model.

Claim 13: Goodwin does not teach or suggest generating deployment descriptors.

Claim 14: Goodwin does not teach or suggest generating end-user documentation, developing unit tests to test the EJB component, and generating a reference implementation of the EJB component.

Claim 15: Goodwin et al. does not teach or suggest verifying the end-user documentation to the EJB component.

Claim 16: Goodwin does not teach or suggest packaging the EJB component for deployment with container managed persistence.

Therefore, because Goodwin fails to teach or suggest any of the claimed steps of claim 1, it follows that Goodwin cannot anticipate independent claim 1. As claims 2-16 depend from independent claim 1, Goodwin cannot anticipate those claims for the same reasons it does not anticipate claim 1. Applicant reserves the right to further address the rejections with respect to claims 2-16 should it become necessary.

Obviousness Rejection

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the

THEOR 205.1 US (10107436)

prior art and not be based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143. Here, the Examiner has failed to establish a prima facie case of obviousness because the combination of Goodwin and Lee does not teach or suggest all the limitations of claims 17 and 18.

As explained above, Goodwin does not teach or suggest any of the steps of claim 1 and therefore of dependent claims 17 and 18. Moreover, as admitted by the Examiner, Goodwin does not teach or suggest that an EJB Component is a "Smart component having at least one of following Smart feature: SmartKey, SmartHandle and SmartValue." (10/16/2007 Office Action at 11). To cure this deficiency, the Examiner turns to Lee. Lee, however, does not teach or suggest: analyzing a business domain to determine functional requirements of said business domain; transforming said functional requirements into an EJB component model; and building an EJB component in accordance with said EJB component model that encompass the business functionality of said business domain. As such, neither Goodwin nor Lee, independently or in combination teaches or suggests each and every element of claims 17-18. Accordingly, the Examiner has failed to establish a prima facie case of obviousness and applicant requests that the obviousness rejection of claims 17-18 be withdrawn.

In view of the foregoing, it is respectfully submitted that Goodwin does not anticipate claims 1 – 16 and that the combination of Goodwin and Lee does not render obvious claims 17 – 19. Accordingly, applicant respectfully requests that these rejections be withdrawn.

THEOR 205.1 US (10107436)

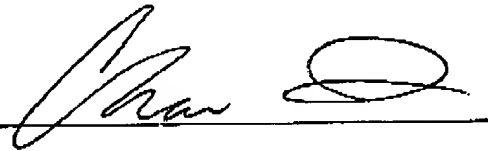
Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0624, under Order No. NY-THEOR-205.1 (10107436) from which the undersigned is authorized to draw.

Dated: January 15, 2008

Respectfully submitted,

Fulbright & Jaworski L.L.P.

By



C. Andrew Im
Registration No. 40,946
FULBRIGHT & JAWORSKI L.L.P.
666 Fifth Avenue
New York, NY 10103
(212) 318-3359
(212) 318-3400 (Fax)
Attorney for Applicants